



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/821,643

04/09/2004

Robert J. Medoff

U 015145-3

9009

140 7590 02/03/2011

LADAS & PARRY LLP

1040 Avenue of the Americas

NEW YORK, NY 10018-3738

EXAMINER

BATES, DAVID W

ART UNIT

PAPER NUMBER

3775

NOTIFICATION DATE

DELIVERY MODE

02/03/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

nyuspatactions@ladas.com

nymail@ladas.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/821,643	<b>Applicant(s)</b> MEDOFF, ROBERT J.	
	<b>Examiner</b> DAVID W. BATES	<b>Art Unit</b> 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,5,27-43,45,54,56,58-61,63,64 and 66-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,27-34,36-43,45,54,56,58-61,63,64 and 66-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 66 is objected to because of the following informalities: in line 1, "wherein the the legs..." needs to have the duplicate "the" removed. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 66 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "The vertical" is an unclear limitation. Some basis for what axis or direction is considered "vertical" needs to be defined.
4. Claim 68 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "loops" is unclear, as it appears to be claiming an enclosed circular configuration.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3775

6. Claims 28, 29, 38-41, 54, 58-61, 63 and 66-69 are rejected under 35

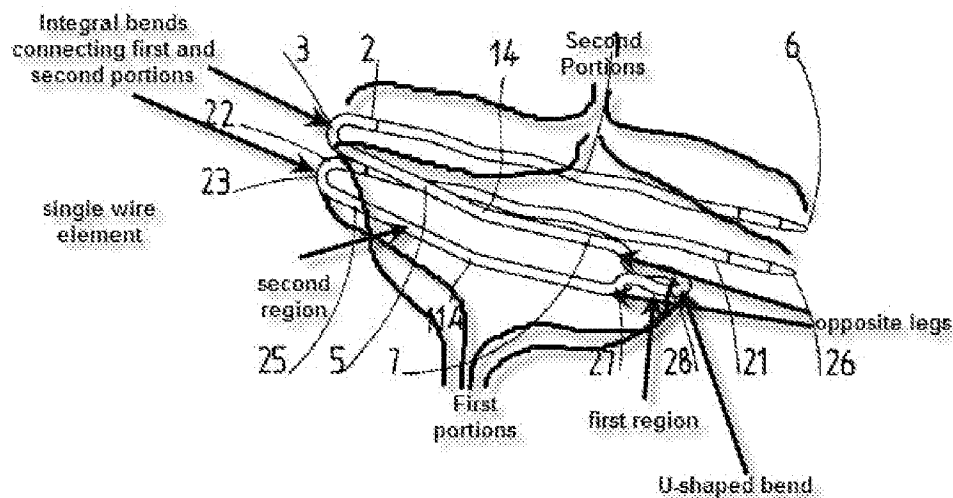
U.S.C. 102(b) as being anticipated by Roussouly (EP 0693272 A1).

7. Regarding claims 38-41, 54, 59-61, 66, 68 and 69, Roussouly has taught an implant for stabilization of an unstable bone fragment in relation to a stable bone fragment as seen at figs. 2, 4 and 5. Roussouly has taught the implant having an offset buttress pin comprising a single wire element 1, the limitations demonstrated in the marked up figure, below. The wire has a U-shaped bend near element 28. Opposite legs (14 and 114) extend from the U-shaped bend 28. The legs each have a first portion that lies in a plane of the U-shaped bend 28 (as shown in the marked up figure; the portions closer to the U-shaped bend than the integral bends at 3 and 23). The legs additionally have a second portion (further from the U 28 than the bends at 3 and 23), the second portions lying in a plane outside the plane of the U-shaped bend 28. The legs have respective bends integrally and continuously joining the first and second portions at 3 and 23 (see marked up figure). The second portion is of sufficient length for bearing against and buttressing the unstable fragment as seen at figs.3 and 4 (the second portion is buttressing against the unstable fragment 35; the second portion holds (buttresses) the bone fragments together). The first portions of the legs have a first region in proximity to the U-shaped bend 28, and a second region in proximity to said second portion (near the bends 3 and 23), said legs being spaced apart in the first region at a distance which is different from the spacing of the legs in the second region (closer to the U, the legs are closer together as seen in the marked up figure).

8. Regarding claims 28 and 29, Roussouly has taught the use of screws (9). The screws have threaded regions, considered to be posts.

9. Regarding claim 58, Roussouly further teaches use of a fixation washer in proximity to the first region (see washer 39; see use at fig. 10).

10. Regarding claims 63 and 67, Roussouly further teaches the tips of the second regions, shown at 6 and 26, to be adapted to enter holes by being tapered.



### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 42, 43, 45, 56 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roussouly.

Art Unit: 3775

13. Regarding claims 42 and 43, Roussouly discloses the claimed invention except for the legs having unequal lengths. It would have been an obvious matter of design choice to select legs of unequal lengths, since applicant has not disclosed that having unequal length legs solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with equal length legs.

14. Regarding claim 45 and 64, Roussouly discloses the claimed invention except for having a bent leg. It would have been an obvious matter of design choice to choose a bent leg, since applicant has not disclosed that having a bent leg solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with a straight leg design.

15. Regarding claim 56, Roussouly discloses the claimed invention except for the use of two buttressing members. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use two of the Roussouly devices, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

16. Claims 1, 4, 5, 27, 33, 34, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roussouly in view of Medoff (US 5,709,682).

17. Regarding claims 1, 4, 5, 27, 33, 34, 36 and 37, Roussouly has taught the claimed limitations of claim 58 and has taught the washer 39 being for laying on the wire element, having a hole therethrough, and having means for preventing rotation and slippage of the washer relative to the legs. Roussouly has taught use of bearings 36.

Art Unit: 3775

Roussouly has not taught the fixation washer having the hole adapted to receive a bone screw to secure the washer and underlying wire element to the stable bone fragment.

Medoff has taught a buttress pin having a washer 46 with a hole therethrough for permitting a bone screw to pass into the stable fragment of bone. See fig. 5. Medoff has taught that doing so would allow for fixation of the device to the stable bone.

It would have been obvious to one with ordinary skill in the art at the time of the invention to substitute the washer 46 and the use of the washer 46 of Medoff for the washer 39 and use of the washer of Roussouly since doing so would have provided improved fixation between the Roussouly device and the stable bone. One would have found it advantageous to make the substitution of the Medoff washer to the Roussouly device since the Roussouly device is of a configuration which connects to the bone more substantially than the Medoff device by wrapping around and back into the stable bone portion with the tips of the second leg portions, and adding the washer would have made the connection even more stable.

18. Claims 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roussouly in view of Medoff and Eitenmuller et al. (US 5,108,399).

19. Regarding claims 30-32, the combination of Roussouly and Medoff has suggested the above claimed limitations of claim 29, but the combination has not suggested the use of a threaded head.

Eitenmuller teaches a bone post (3.0) having a threaded head portion. It would have been obvious to one with ordinary skill in the art at the time of the invention to incorporate the use of the threaded bolt of Eitenmuller with the device of the

combination to predictably achieve the result of attaching a fixation element to the bone. One would have done so to allow for attachment of a nut to the top of the screw to allow for improved holding of the fixation element.

### ***Response to Arguments***

20. Applicant's arguments with respect to claims 38-45 and 58-67 have been considered but are moot in view of the new grounds of rejection. The new rejections were necessitated by applicant's amendments to the claims.

### ***Conclusion***

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID W. BATES whose telephone number is



Art Unit: 3775

(571)270-7034. The examiner can normally be reached on Monday-Friday 9:00AM - 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. W. B./

Examiner, Art Unit 3775

/EDUARDO C. ROBERT/

Supervisory Patent Examiner, Art Unit 3733